

REMARKS**I. Introduction**

Claims 1-25 are pending in the above application.

Claims 1-6, 10, 12, 17-21 and 25-26 stand rejected under 35 U.S.C. § 102.

Claims 7-9, 11, 13-16 and 22-24 stand rejected under 35 U.S.C. § 103.

Claims 1, 15 and 17 are independent claims.

III. Prior Art Rejections

A. Claims 1-6, 10, 12, 17-21 and 25-26 stand rejected under 35 U.S.C. § 102 as being anticipated by McKinnon III et al. (2001/0039582).

Anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed in a prior art reference as arranged in the claim. See, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986); and *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193, 198 (Fed. Cir. 1983).

As explained in Applicant's previous response, McKinnon III does not disclose or suggest a data switching system in communication with a plurality of network elements, said data switching system being adapted to query said network elements from time to time for status information and to store the status information in a database; and a management system for managing network elements on the cable network, said management system being adapted to obtain network element status information from said database, wherein the data switching system queries said network elements by a ranging request, and the status information is determined based on a response by a network element to the ranging request, as recited by amended claim 1. McKinnon III also does not disclose providing a ranging request signal from the data switching system to each of the network elements of the plurality of network elements; determining status information for each of the plurality of network elements based on a response from each of the

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plurality of network elements to the communication signal, respectively, as recited by amended claim 17.

McKinnon III discloses to issue queries from a data collector 88 contained in network access manager 86 to the CMTS and CM to monitor the network access. Figs. 5 and 6; para. 65. McKinnon III specifically discloses to issue a separate query signal to monitor the network access and does disclose to rely on results of ranging request signals from the CMTS to the network elements. Accordingly, McKinnon does not disclose each and every limitation of amended claims 1 or 17 and does not anticipate amended claims 1 or 17. Likewise, McKinnon III does not anticipate claims 2-6, 10 or 12 which depend on amended claim 1, nor claims 18-21 and 25 which depend on amended claim 17.

Contrary to the assertion in the final Office action, McKinnon III also does not disclose providing a ranging request signal from the data switching system to each of the network elements of the plurality of network elements. McKinnon III simply issues queries to the CMs to which counter values of logical data units (LDUs) are provided, where LDU are clearly described as "the number of bytes and the number of data packets that are transmitted." Para. 65. The Examiner's apparent substitution of a "ranging request" with McKinnon III's LDUs is clearly improper. Such substitution is effectively rewriting Applicant's claims for the sole purpose of rejecting them. Ranging requests are defined in Applicant's application at least at paragraph 31, and are a routine communication primarily intended to ensure appropriate timing of the communication signals. LDU's are defined in McKinnon III as relating to specific data information. The need in McKinnon III to request a specific data signal from the modems creates exactly the problem of congestion on the communication lines that Applicant's invention is intended to solve.

Moreover, anticipation requires disclosure of each and every element from a single reference, i.e. either the reference discloses the claimed features or not. Anticipation cannot be supported by rationalization such as the non-legal rationale of "design choice." Consideration of a "design choice" only has applicability in an obviousness rejection. Indeed, the need to rely on such rationalization to support the rejection only makes it clear that the legal requirements of anticipation are not met.

Accordingly, as the rejection is improper, Applicant respectfully requests the rejection to be withdrawn.

B. Claims 7, 9, 11, 15 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over McKinnon III in view of Hsieh (U.S. Pat. No. 6,512,824).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *Ecolochem Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 56 U.S.P.Q.2d (BNA) 1065 (Fed. Cir. 2000); *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2D (BNA) 1614, 1617 (Fed. Cir. 1999); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992); and *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). See also MPEP 2143.01.

Neither McKinnon nor Hsieh, taken alone or in combination, disclose or suggest all of the limitations of amended claim 1, upon which claims 7, 9 and 11 depend, nor the limitations of amended claim 15, nor the limitations of amended claim 17, upon which claim 22 depends. McKinnon does not disclose such as discussed above. Hsieh discloses a proxy database for an element management system of a telephone switching network. Hsieh also does not disclose the features of amended claims 1, 15 and 17, and the Office action does not rely on Hsieh as disclosing such features.

Accordingly, as neither McKinnon nor Hsieh, taken alone or in combination, disclose or suggest all of the limitations of amended claim 1, upon which claims 7, 9 and 11 depend, nor the limitations of amended claim 15, nor the limitations of amended claim 17, upon which claim 22 depends, the combination of McKinnon and Hsieh does not render these claims unpatentable.

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C. Claims 8, 14, 16 and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over McKinnon III in view of Carlson et al. (U.S. Pub. No. 2004/0210632).¹

Neither McKinnon nor Hsieh, taken alone or in combination, disclose or suggest all of the limitations of amended claim 1, upon which claims 8 and 14 depend, nor the limitations of amended claim 15 upon which claim 16 depends, nor the limitations of amended claim 17, upon which claim 23 depends. McKinnon does not disclose such as discussed above. Carlson discloses a distributed network management system with a hub server and remote servers. Abs. Carlson also does not disclose the features of amended claims 1, 15 and 17, and the Office action does not rely on Carlson as disclosing such features.

Accordingly, as neither McKinnon nor Carlson, taken alone or in combination, disclose or suggest all of the limitations of amended claim 1, upon which claims 8 and 14 depend, nor the limitations of amended claim 15 upon which claim 16 depends, nor the limitations of amended claim 17, upon which claim 23 depends, the combination of McKinnon and Carlson does not render these claims unpatentable.

D. Claims 13 and 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over McKinnon III in view of Applicant's Alleged Admitted Prior Art (APA).

Neither McKinnon nor APA, taken alone or in combination, disclose or suggest all of the limitations of amended claim 1, upon which claim 13 depends, nor the limitations of amended claim 17, upon which claim 24 depends. McKinnon does not disclose such as discussed above. APA is relied on as allegedly disclosing that DOCSIS requirements specify an RF Management

¹ Applicant notes that claim 16 depends on independent claim 15 and incorporates all of the limitations thereof. However, while the Office action relied on Hsieh to reject claim 15, Hsieh was not relied upon to reject claim 16. Accordingly, the rejection of claim 16 appears to be structurally defective.

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Information Base (MIB). APA also does not disclose the features of amended claims 1 and 17, and the Office action does not rely on APA as disclosing such features.

Accordingly, as neither McKinnon nor APA, taken alone or in combination, disclose or suggest all of the limitations of amended claim 1, upon which claim 13 depends, nor the limitations of amended claim 17, upon which claim 24 depends, the combination of McKinnon and APA does not render these claims unpatentable.


IV. Conclusion

Having fully responded to the Office action, the application is believed to be in condition for allowance. Should any issues arise that prevent early allowance of the above application, the examiner is invited contact the undersigned to resolve such issues.

To the extent an extension of time is needed for consideration of this response, Applicant hereby request such extension and, the Commissioner is hereby authorized to charge deposit account number 502117 for any fees associated therewith.

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Respectfully submitted,

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